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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/613,689

07/03/2003

Eric Chalendar

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MeadWestvaco Corporation
Law Department
4850D North Church Lane
Smyrna, GA 30080

EXAMINER

HARMON, CHRISTOPHER R

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,689

Applicant(s)

CHALENDAR ET AL.

Examiner

Christopher R. Harmon

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission with respect to the claims filed on 8/23/06 has been entered.

The amendment with respect to the specification is not entered. Applicant is required to resubmit the amendment with reference to the originally filed specification not published application US 2004/0068961. The content of the amendment has been determined to be void of new matter and will be approved upon resubmission.

Drawings

2. The drawings received on 8/23/06. These drawings are approved.

Priority

3. As noted in the previous actions of 6/2/06 and 10/31/05, the claim for priority has not been perfected.

Claim Objections

4. The previous claim objection with respect to claims 19-36 is maintained. Because the second and third directions of travel are the same in the specification, referring to the two directions as separate elements creates inconsistencies with the

Art Unit: 3721

specification. Usually this same construction in a claim creates an assumption that they are in fact two separate directions. Note that where an applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 27 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear how the conveyor chains are perpendicularly disposed with respect to one another, note all conveyor chains seem to be disposed/aligned substantially vertically.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless – (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 19-24, 26, 28-29, 31-33, 37-41, 43, 45-46, and 48-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Ganz (US 3,848,519).

Ganz discloses an apparatus for packaging an array comprising article conveyor 12; packaging material conveyor 14 for conveying packaging material in a perpendicular direction (downward) to the article conveyance direction; packaging material accelerators 28L and 28R adapted and synchronized to receive the individual packaging materials from conveyor 14 and place over array of bottles b on conveyor 12; compression mechanism 106; control system/drive mechanism that synchronizes the conveyors; see figure 1. The packaging materials have cells for holding articles b; see figure 15.

The process is continuous therefore erecting elements 30 disposed adjacent conveyor 14 are adapted for erecting cells during packaging material conveyance by packaging material conveyor 14. Erecting elements include reciprocating element 110 which engages portion km of the packaging and travels on a curvilinear path. This path is considered both circular and oval shaped; see figure 1.

Regarding claims 26 and 43, packaging material conveyor 14 is positioned in an overlapping configuration with packaging material accelerator 28.

Regarding claims 28 and 45, note that while features of an apparatus may be recited either structurally or functionally, claims directed towards an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Schreiber*, 128 F.3d 1473-78, 44 USPQ2d 1429-32 (Fed.Cir. 1997) and *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528

(Fed.Cir. 1990). The velocities specified are more appropriate for a process claim. The examiner takes the position that the separate assemblies of the invention to Ganz are fully capable of being run at different velocities if desired.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 25 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganz (US 3,848,519) in view of Ford (US 5,626,002).

Ganz does not directly disclose an adhesive mechanism but rather an interlocking tab construction. Ford discloses both the use of adhesive and interlocking tab and hole construction for securing panels of carrier packaging materials; see column 2, first paragraph. It would have been obvious to one of ordinary skill in the art to include an adhesive applicator as taught by Ford in the invention to Ganz for securing panel members during the erection procedure.

11. Claims 27 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganz (US 3,848,519).

Ganz does not directly disclose the packaging material conveyor with two opposing endless chains but rather only one carrying a series of lugs 20 for engaging the packaging material. However, it would have been obvious to one of ordinary skill in

Art Unit: 3721

the art to provide two endless chains (one for each tooth in lug 20) since it has been held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. See, *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Also, duplication of the essential working parts of a device involves only routine skill in the art and that "section 103 cannot easily be satisfied by inventions that rearrange old elements in new combinations with each element performing the same function it performed in the prior art, even though the new combination produces a more striking result than the old ones. *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 452-453 (1976). Unless the combination is "synergistic, that is, 'result[ing] in an effect greater than the sum of the several effects taken separately,'" it cannot be patented. *Id.*, citing Anderson's -- *Black Rock v. Pavement Co.*, 396 U.S. 57, 61, 163 USPQ 673, 674-675 (1969)." *St. Regis Paper Company v. Bemis Company, Inc.*, 193 USPQ 8 (1977).

12. Claims 30 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganz (US 3,848,519) in view of Konzal et al. (US 4,819,411).

Ganz discloses endless chains 34 having a working reach terminating proximate article conveyor 12; see figure 1. Because of applicant's traversal of the previously asserted common knowledge modification that endless chains can be replaced with belts on a conveyor Konzal et al. is relied upon for a direct teaching. Note Konzal et al. disclose the alternative of endless chains and belts 282 of a conveyor 280; see column 7, lines 42+.

It would have been obvious to one of ordinary skill in the art at the time of the invention to replace the endless chains of Ganz with endless belts as taught by Konzal et al. for carrying the engaging elements of the packaging material accelerator.

13. Claims 34-36 and 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganz (US 3,848,519) in view of Buckingham et al. (US 4,237,676).

Ganz does not directly disclose a packaging material detector or an article array position detector however in a similar automated packaging device Buckingham et al. disclose packaging arrays of bottles using a control system comprising packaging material detector/photocell P1; detector head/array detector (not shown); see column 10, lines 51+. These are run by a control system/controller as are the conveyors of Ganz. Whether or not Buckingham et al. disclose a central processor is moot due to Applicant's previous admission that central processors and input means are well known devices in this environment; see Non-Final Rejection of 10/31/05.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the control system with sensors of Buckingham et al. in the invention to Ganz for increased precision and elimination of defective packages.

Response to Arguments

14. Applicant's arguments filed 8/23/06 have been fully considered but they are not persuasive. With respect to Ganz, elements 28L and 28R act as accelerators of products delivered from conveyor 14 as portions are gripped and manipulated in a perpendicular direction of the first direction of travel. This manipulation causes opening

Art Unit: 3721

of the products and is considered accelerating those portions manipulated. Note that during patent examination, the pending claims must be interpreted as broadly as their terms reasonably allow. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 320,322 (Fed. Cir. 1999). In determining the patentability of claims, the PTO gives claim language its broadest reasonable interpretation" consistent with the specification and claims. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See MPEP § 904.1.

Regarding the control system/drive mechanism Ganz clearly discloses mechanical means for controlling the elements including chains 34; sprockets 70-73; drive shaft 74; etc. see column 5, lines 50+.

Regarding applicant's confusion with regard to the relevance to the packaging cells, see claim 19, last line etc.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the erecting mechanism be separate and apart from the package material accelerator) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With regard to claims 28 and 45, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language such as "adapted to" that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or

Art Unit: 3721

claim limitation. The suggestion/reference to a process claim was merely a remark regarding claim interpretation. Note that a limitation directed to an intended use of an apparatus or a process requires a structural difference or a manipulative difference between the claimed invention and the prior art. See *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963); *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Thus the intended velocity of the operation is not considered a limiting factor as the invention to Ganz is considered capable of being controlled as claimed. It is noted that the operation as disclosed of Ganz is synchronized ie. package material conveyor 14 and accelerators 28L and R in order to function properly however does not invalidate the capability of the invention to function differently if so intended by a user.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, tab and opening construction in respective panels and glued panels are merely well known alternative closing structures in the art. One does not necessarily teach away from the other as one of ordinary skill would easily recognize the different positive and negative aspects of either closure system.

Art Unit: 3721

Regarding the previously recognized admission (Applicant's admitted prior art) the arguments are untimely. See MPEP 2144.03(c).

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Harmon whose telephone number is (571) 272-4461. The examiner can normally be reached on Monday-Friday from 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Chris Harmon
Patent Examiner